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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,931	06/30/2000	Jay S. Walker	99-099	2766
22927	7590	05/19/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/609,931

Applicant(s)

WALKER ET AL.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24,27-30,33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24,27-30,33 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 and 13 recite "an attendant", but an attendant has already been recited in claim 1. It is not clear whether, the claims refer to a different attendant or the attendant of claim 1.

### ***Note Regarding Examination***

In the previous Office Actions, it was noted that certain subject matter was old and well known in the art. As directed by 2144.03(c) the statements that the subject matter is old and well known are taken to be admitted prior art since an adequate traversal of the statements was not presented in the replies subsequent to those actions. The traversals were not adequate because no statement was made as to why the noticed subject matter is not considered old and well known in the art.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 8, 14, 15, 22, 24, 27, 30, 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (5,926,796).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to claims 1 and 30, '796 shows receiving customer transaction information; identifying a query based on the customer information; outputting the query; prompting an attendant to present the query; and receiving a verbal response.

As to claims 2, 5, 8, 14, 22 and 24, all elements are shown by '796.

As to claim 15, '796 shows generating an output to the analysis based on the verbal response and categorizing the output (comprising e.g., outputting and categorizing whether whether or not it is necessary to carry out the subscription process based on the customer's answer).

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As to claim 27, '796 shows identifying a remediation response based on the verbal response to the query; and instructing the attendant to present the response (comprising e.g., identifying carrying out the subscription process to remedy the incorrect transaction taking place – the sale of the single issue, and presenting the response. It is noted that it is inherent that the attendant is instructed to present the response since in '796 doing so is part of his job, so upon making the determination that it is appropriate to carry out the subscription process, he is instructed by the management and the terms of his employment to do so.)

As to claim 35, '796 shows receiving at a first processing device first customer information including information identifying a first product; selecting a query based at least in part on the first product (comprising whether the customer would like a subscription); prompting the attendant to present the question; receiving a verbal response; analyzing the response to determine if a mediation response is required (comprising e.g., determining whether the transaction type needs to be changed from a single copy to a subscription and the subscription process carried out); and instructing the attendant to perform the remediation. (It is noted that it is inherent that the attendant is instructed to present the response since in '796 doing so is part of his job, so upon making the determination that it is appropriate to carry out the subscription process, he is instructed by the management and the terms of his employment to do so.)

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Claims 1, 2, 5-10, 12, 14, 15, 22, 24, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Fredregill et al (6,138,911).

As to claims 1 and 30, '911 shows receiving customer transaction information; identifying a query based on the customer information; outputting the query; prompting an attendant to present the query; and receiving a verbal response (e.g., whether the customer wants to use points to reduce the price of a redemption item).

As to claims 2, 22 and 24, all elements are shown by '796.

As to claims 5-10 and 14, '911 shows all elements.

As to claim 12, customer information identifying the customer is identified by the attendant, since he enters it.

As to claim 15, output comprising whether or not to apply the points to the purchase, based on the verbal response to the query, and categorizing the output as to yes or no.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 13, 16, 17, 19, 20, 23, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over '911.

'911 shows all steps except identifying a second query, outputting a second question, receiving and analyzing a second response. However, it is notoriously old and well known in the art to identify, ask, receive answers to, and analyze a plurality of questions. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by doing so in order to enable handling of transactions where more than one redemption item is purchased, thereby allowing the customer to use his bonus points on more than one item.

As to claim 13, '911 shows all elements of the claim except that identifying the query is based at least in part on the authority level of the attendant. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by doing so in order to avoid large losses caused by an inexperienced person having a low authority level.

As to claims 16 and 17, '911 shows all elements of the claims except identifying a second query based on the categorizing of the output data of the first; prompting an attendant to present the second; and receiving and analyzing the verbal response. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by doing so in order to facilitate the more flexible use of points.

As to claim 19, '911 shows all elements of the claim except identifying the attendant. However to do so is notoriously old and well known in the art (e.g., for the cashier to insert a card upon the beginning of a shift with ID information or enter it into the keyboard.) It would have been obvious to one of ordinary skill in the art to modify

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the method of '911 by identifying the attendant in order to enable tracking of errors and differences at the station.

As to claims 20 and 28, '911 shows all elements of the claim except analyzing if the attendant properly presented the query. However to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by analyzing whether the attendant properly presented the query in order to ensure that the customer receives the proper messages. Regarding compensating the attendant for properly presenting the query, it is noted that it is inherent that attendant is compensated for the proper performance of his duties, including proper presentation of the queries.

As to claim 23, '911 shows all elements of the claim except receiving a response comprising selectively recording the response. However to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by receiving a response comprising selectively recording the response in order to permit machine analysis of the response and to save the interchange for later quality control analysis.

Claims 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over '911 in view of Plainfield et al (5,893,075).

'911 shows receiving customer information; identifying a question based at least in part on customer information; outputting and indication of the question; prompting an attendant to present the question and receiving a response. '911 does not show that



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the questions are survey questions. Plainfield et al show the use of survey questions. It would have been obvious to one of ordinary skill in the art to modify the method of '911 by having the system select a survey question in order to better serve the customer and to better focus marketing efforts.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over '911 in view of the [www.atpos.com](http://www.atpos.com) webpages.

The method of '911 shows all elements of the claim except receiving customer information via a portable computing device. [www.atpos.com](http://www.atpos.com) shows such a device. It would have been obvious to one of ordinary skill in the art to modify the method of '787 by providing such a device in order to read data from smart cards and so on and to provide portability so that the POS could be set up where needed.

Claims 16-18 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over '796.

Claims 16-18 show all elements, including identifying a second query, prompting the attendant to present the second query, receiving the verbal response, analyzing the response, generating output data based on the response, and categorizing the output data since it is necessary to determine a prompt the attendant to present a second query comprising which subscription length is desired, to receive the response, to

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analyze the response, generate output and categorize the output representing which the desired subscription length to be sold.

Alternatively, as to claims 16-18, '796 shows all elements of the claims except identifying a second query, prompting the attendant to present the second query, receiving the verbal response, analyzing the response, generating output data based on the response, and categorizing the output data. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of '796 by doing so in order to enable the customer to have a choice of subscription lengths.

Claims 20, 23, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over '796.

As to claims 20 and 28, '796 shows all elements of the claim except analyzing if the attendant properly presented the query. However to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '796 by analyzing whether the attendant properly presented the query in order to ensure that the customer receives the proper messages. Regarding compensating the attendant for properly presenting the query, it is noted that it is inherent that attendant is compensated for the proper performance of his duties, including proper presentation of the queries.

As to claim 23, '796 shows all elements of the claim except receiving a response comprising selectively recording the response. However to do so is notoriously old and

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well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '796 by receiving a response comprising selectively recording the response in order to permit machine analysis of the response and to save the interchange for later quality control analysis.

As to claim 29, '796 shows all elements of the claim except analyzing if the attendant properly presented the remediation. However to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '796 by analyzing whether the attendant properly presented the remediation in order to promote customer satisfaction. Regarding compensating the attendant for properly presenting the remediation, it is noted that it is inherent that attendant is compensated for the proper performance of his duties, including proper presentation of the remediation.

(Regarding the recitation of providing compensation based on proper presentation of the remediation or query, it is noted that as claimed the compensation is not based on the analysis of the presentation and that compensation for performing the job therefor encompasses compensation for performing all tasks properly, including the presentation of the remediation response or query.)

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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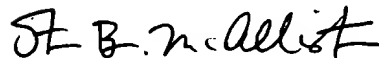
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven B. McAllister  
Primary Examiner  
Art Unit 3627



Steven B. McAllister

**STEVE B. McALLISTER**  
**PRIMARY EXAMINER**